

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SOUMEN CHAKRABARTI, BYRON EDWARD DOM, DAVID
ANDREW GIBSON, KEVIN SNOW MCCURLEY and MARTIN HENK
VAN DEN BERG

Appeal No. 2006-2651
Application 09/523,639
Technology Center 2100

Decided: February 28, 2007

Before JOSEPH F. RUGGIERO, MAHSHID D. SAADAT,
and JEAN R. HOMERE, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal from the Examiner's final rejection of claims 1 through 7, 9 through 13 and 15 pursuant to 35 U.S.C. § 134. We have jurisdiction under 35 U.S.C. § 6(b) to decide this appeal.

The Examiner rejected the pending claims as follows:

- A. Claims 1 through 4, 7, 9, 10, 13 and 15 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over the combination of Adar and Jammes.
- B. Claims 5, 6, 11 and 12 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over the combination of Adar, Jammes and Khan.

The Examiner relied on the following references:

Jammes	US 6,484,149 B1	Nov. 19, 2002
Adar	US 6,493,702 B1	Dec. 10, 2002
Khan	US 6,546,393 B1	Apr. 08, 2003

Independent claim 1 is illustrative and representative of the Appellants' invention. It reads as follows:

1. A computer system, comprising:

- at least one user computer;

- a data input device associated with the user computer;

- a Web server communicating with the user computer;

server logic means at the Web server for generating a table of inlinks to at least one Web page associated with the Web server, at least one inlink including information related to a source page and information related to a target page linked to from the source page; and

user logic means at the user computer for accessing the table of inlinks to facilitate generating a list of sibling links based on the table, each sibling link being an outlink of one of the inlinks in the table, for accessing the sibling links.

Appellants contend that claims 1 through 7, 9 through 13 and 15 would not have been obvious over Adar in combination with Jammes.¹ Particularly, Appellants contend that the Adar-Jammes combination does not fairly teach or suggest a table at a web server containing inlink information pertaining to a source page, as recited in claim 1. (Br. 5). Appellants also contend that the Examiner failed to provide sufficient motivation to combine Adar and Jammes to yield the invention as recited in claims 7, 13 and 15. (Br. 6).

The Examiner contends that Adar teaches the claimed inlink information relating to a source page, recited in claim 1, as a bookmark page having a list of links from which a user selects a hyperlink to a target page (Answer 4 and 7). The Examiner further concludes that it would have been obvious to one of ordinary skill in the art to combine Adar with Jammes to yield the claimed invention, as recited in claims 7, 13 and 15.

We affirm in part.

¹ This decision considers only those arguments that Appellants submitted in the Appeal and Reply Briefs. Arguments that Appellants could have made but chose not to make in the Briefs are deemed to have been waived. See 37 CFR 41.37(c)(1) (vii)(eff. Sept. 13, 2004). See also In re Watts, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004).

ISSUES

The *pivotal* issues in the appeal before us are as follows:

- (1) Under 35 U.S.C. § 103 (a), would one of ordinary skill in the art at the time of the present invention, have found that the Adar-Jammes combination renders the claimed invention unpatentable when Adar teaches a bookmark page having a list of bookmarks from which a user selects a hyperlink as a target page?
- (2) Under 35 U.S.C. § 103 (a), would one of ordinary skill in the art at the time of the present invention, have found sufficient motivation to combine Adar with Jammes by incorporating sibling links into a list of links in a bookmark page?

FINDINGS OF FACT

Appellants invented a system for generating at a web server (32) a table of inlinks (44) indicating source and target pages information. Particularly, when a user hyperlinks to a target page from a source page, the web server of the target page records in the table the identity of the source page. The invention also generates at a user computer (12) a list of sibling links, each being an outlink of one of the inlinks to a target page. (Specification 8 and 9).

Adar discloses a search and recommendation system that employs the preferences and profiles of individual users and groups within a community, as well as information derived from shared document bookmarks to enhance users' searches. (Abstract, ll. 1-5). Particularly, Adar discloses a bookmark database (120) that maintains a set of inlinks grouped in a bookmark page for each of a plurality of users (110-116). For each registered user, the

database particularly maintains a list of bookmarks including a list of categories, the user's screen name, as well as the time the bookmark was last accessed, and updated. The system also contains an availability icon indicating whether a link in the bookmark is inactive or unavailable. (col. 5, l. 60- col. 6, l. 34).

Jammes discloses a system for automatically customizing a webpage to fit shopping behaviors of individual consumers. The system allows merchants to establish a user-interface with a navigable hierarchy of products and categories, and stores in a database consumer web views containing user product information, preferences and associated hyperlinks including sibling links.(col. 3, l. 34; figure 18, elements 1818-1822). Particularly, Jammes discloses a product information database (116) having a relationship table (202) with sibling links (1818-1820) for satisfying a user query. (col. 46, ll. 32-38).

PRINCIPLES OF LAW

OBVIOUSNESS (Prima facie)

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does

the burden of coming forward with evidence or argument shift to the Appellants. *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. *See also Piasecki*, 745 F.2d at 1472, 223 USPQ at 788. Thus, the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion.

OBVIOUSNESS (Motivation)

On appeal, Appellant bears the burden of showing that the Examiner has not established a legally sufficient basis for combining the teachings of the references that the Examiner relied upon. Appellant may sustain this burden by showing that the Examiner failed to provide sufficient evidence to support that one having ordinary skill in the art would have combined disclosures of the references, as proposed by the Examiner, to yield Appellant's invention. *United States v. Adams*, 383 U.S. 39 (1966); *In re Kahn*, 441 F.3d 977, 987-988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006); *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick, Co.*, 464 F.3d 1356, 1360-1361, 80 USPQ2d 1641, 1645 (Fed. Cir. 2006). The mere fact that all the claimed elements or steps appear in the prior art is not *per se* sufficient to establish that it would have been obvious to combine those elements. *United States v. Adams, supra*; *Smith Industries Medical systems, Inc. v. Vital Signs, Inc.*, 183 F.3d 1347, 1356, 51 USPQ2d 1415, 1420 (Fed. Cir. 1999). However, "[a]s long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor." *In re Beattie*, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992). Motivation to combine references

under 35 U.S.C. § 103 must come from a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources, to select particular elements, and to combine them as combined by the inventor. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 665, 57 USPQ2d 1161, 1167 (Fed. Cir. 2000) .

“[A]n implicit motivation to combine exists not only when a suggestion may be gleaned from the prior art as a whole, but when the ‘improvement’ is technology-independent and the combination of references results in a product or process that is more desirable, for example because it is stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient In such situations, the proper question is whether the ordinary artisan possesses knowledge and skills rendering him *capable* of combining the prior art references.”

DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co., 464 F.3d 1356, 1368, 80 USPQ2d 1641, 1651 (Fed. Cir. 2006).

ANALYSIS

The Examiner improperly relied upon Adar’s teachings in combination with Jammes’ to render claim 1 obvious. Particularly, the Examiner erred in finding that Adar’s teaching of a bookmark page with a plurality of links for a user corresponds to Appellants’ limitation of a table of inlinks at a webserver, as recited in claim 1, where at least one of the inlinks includes information relating to a source page and a target page. One of ordinary skill in the art would have readily recognized that Adar’s bookmark page for a particular user cannot be construed as a source page that has a particular

link associated with it. The ordinarily skilled artisan would have aptly appreciated that, absent a clear teaching of a URL to access a webpage that contains a list of user's links, a bookmark page is generally accessed through the menu bar of the user's internet browser. Generally, such a bookmark page does not have a link associated with it. In this case, we fail to find any particular teaching in Adar indicating that the bookmark page for a user can be retrieved via a link. Therefore, the ordinarily skilled artisan would have readily recognized that Adar's bookpage is not a source page. After considering the entire record before us, we find that the Examiner erred in rejecting claim 1 over the combination of Adar and Jammes. We also find that the Examiner erred in rejecting dependent claims 2 through 4 over the combination of Adar and Jammes. We have considered the Khan reference, which the Examiner added to address the claimed limitation of pruning an inlinks table in response to a selected criterium. We find nothing, however, in Khan which overcomes the deficiencies of previously discussed Adar and Jammes. Consequently, we find that the Examiner erred in rejecting dependent claims 5 and 6 over the combination of Adar, Jammes and Khan. Next, we find that the Examiner properly rejected independent claims 7, 13 and 15 over the combination Adar and Jammes. Particularly, the Examiner found sufficient motivation to combine the cited references to yield the invention as claimed. We note that both Adar and Jammes are concerned with resolving the problem of customizing a user's search interface by providing users with a group of links that fit their particular needs. One of ordinary skill in the art of online data retrieval, at the time of the present invention, would have readily recognized that by incorporating sibling links into a list of links stored in a bookmark page, the user search capabilities

would be augmented. Therefore, by expanding the user's search pool with more pertinent target pages (sibling links), the combined system would recommend and retrieve documents to users in a more effective and efficient manner. After considering the entire record before us, we find that the Examiner did not err in rejecting claims 7, 13 and 15 over the combination of Adar and Jammes. We also find that the Examiner did not err in rejecting dependent claims 9 through 12 over the combination of Adar and Jammes.²

CONCLUSION OF LAW

On the record before us, one of ordinary skill in the art, at the time of the present invention, would not have found that the Adar-Jammes combination renders the claimed invention unpatentable under 35 U.S.C. § 103 (a) when Adar teaches a bookmark page having a list of bookmarks from which a user selects a hyperlink to a target page. The ordinarily skilled artisan, however, at the time of the present invention, would have found sufficient motivation to combine Adar with Jammes by incorporating sibling links into a list of links in a bookmark page.

² Appellants have not presented any substantive arguments directed separately to the patentability of the dependent claims. In the absence of a separate argument with respect to the dependent claims, those claims stand or fall with the representative independent claim. *See In re Young*, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii).

DECISION

We reverse the Examiner's decision to reject claims 1 through 4 under 35 U.S.C. § 103 (a) as being unpatentable over the combination of Adar and Jammes. We also reverse the Examiner's decision to reject claims 5 and 6 under 35 U.S.C. § 103 (a) as being unpatentable over the combination of Adar, Jammes and Khan. We, however, affirm the Examiner's decision to reject claims 7, 9, 10, 13 and 15 under 35 U.S.C. § 103 (a) as being unpatentable over the combination of Adar and Jammes. We also affirm the Examiner's decision to reject claims 11 and 12 under 35 U.S.C. § 103 (a) as being unpatentable over the combination of Adar, Jammes and Khan.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

pgc/ce

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